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10/736,024	12/15/2003	Thomas E. Creamer	BOC9-2003-0078 (449)	4171

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EXAMINER
SHIN, KYUNG H

ART UNIT	PAPER NUMBER
2143	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 September 2007</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1 – 3, 5 – 9, 11 -15, 17, 18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1 – 3, 5 – 9, 11 -15, 17, 18</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119.

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is responding to application amended on 9/18/2007.

2.   Claims **1 – 3, 5 – 9, 11 -15, 17, 18** are pending.   Claims **1, 5, 6, 7, 11, 12, 13, 17, 18** have been amended.   Claims **4, 10, 16** have been cancelled.   Claim **1, 7, 13** are independent.

Response to Arguments

3.   Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

3.1   Applicant argues that the referenced prior art does not disclose that, "a party desiring to make contact with another is unavailable to initiate contact". (see Remarks Page 10)

The specification in paragraph [0024] indicates that the user has to initiate the service. The user must be available in order to initiate the service.   And, the user is unavailable when the attempted contact is initiated.   Brown discloses the capability for a schedule to be setup for later (unattended) initiation of the contact service.   (see Brown paragraph [0067], lines 1-8; paragraph [0069], lines 1-5; paragraph [0087], lines 4-8: schedule, automatic initiation of call (contact))   The setup of a scheduled time to initiate an action is well know in the art and implies that the user is unavailable (or the action is automatically initiated) at that instance in time.

3.2   Applicant argues that the referenced prior art does not disclose, "a user-

customizable rule that specifies information which pertains specifically to the other entity

and that is to be elicited from the other entity, as also". (see Remarks Page 10)

Brown discloses the capability for the user to setup rules to be utilized to process

the contacts on a contact list. (see Brown paragraph [0026], lines 8-12: setup rules by

user) The rules determine how the response is to be delivered to the caller. Brown

discloses that a called party can determine multiple ways to respond to the caller. (e-

mail, instant message, etc).   Brown discloses that information is obtained from the

called party, namely, the caller can accept, or reject the call.   This is eliciting

information pertaining to the called party and the information obtained is concerning the

called party. (see Brown paragraph [0031], lines 5-9; paragraph [0042], lines 1-7;

paragraph [0071], lines 3-10: accept, reject the call by the called party, information

obtained from receiver of contact)   There is no disclosure in the specification or the

original claims as to what specific type of information that is to be obtained.   The

specification merely states that the information obtained is based on the service and

connection rules setup by the user.

3.3   Applicant argues, "rules, however, are established by the called party, which is not

comparable to the user of Applicants' invention". (see Remarks Page 12)

Brown discloses that the rules are setup by the subscriber (user). (see Brown

paragraph [0024]). The citation in paragraph [0054] merely states an additional function

of the Brown prior art, namely, the capability for the called party to have a say in the

setup of rules. Brown discloses that the subscriber (user) sets up the rules as per the claim limitations. (see Brown paragraph [0026], lines 8-12: setup rules by user)

3.4   Applicant argues that the referenced prior art does not disclose, "Brown's rules do not have anything to do with specifying the information pertaining specifically to an entity or party that is to be elicited once contact is established". (see Remarks Page 11)

Brown discloses the acceptance or rejection of the call by the called party or entity on the user's contact list. The acceptance or rejection of a call is information specifically pertaining to an entity (called party) after contact is established. (see Brown paragraph [0031], lines 5-9; paragraph [0042], lines 1-7; paragraph [0071], lines 3-10: accept or reject call, information obtained) This information is obtained from the called party (contact).

3.5   Applicant argues that the referenced prior art does not disclose, "Brown's "completion rules" pertain to a call set up only. Accordingly, Brown's rules do not have anything to do with specifying the information pertaining specifically to an entity or party that is to be elicited once contact is established". (see Remarks Page 11)

A call setup is still a contact as per claim limitations. Contact information is elicited since information such as acceptance or rejection of the call is obtained from the called party (the contact). The limitations only disclose that a contact satisfies the contact (service) rules. The claim limitations for claims 3, 9, 15 state that the at least one service rule is selected from at least one of how to contact one entity, what to ask that at least one entity, a time period to contact the at least one entity. Brown discloses

service rules such that the rules determine how to contact the entity plus a time period

for contacting the entity. (see Brown paragraph [0026], lines 8-12: rule for how to

contact entity; paragraph [0029], lines 1-6: time period utilized in processing contact

information)

3.6   Brown discloses the capability to initiate a call when the user is unavailable

utilizing a scheduling mechanism. Brown discloses the capability to receive information

(elicited information) from the called party (contact). And, Brown and Yoakum disclose

the capability to contact all of the entries on a contact list.

The examiner has considered the applicant's remarks concerning a method, a

system, and an apparatus for permitting a user to remain in contact with at least one

other person. The present invention provides a method, a system, and an apparatus

that is capable of enabling a user to remain in contact with others through a service that

checks contacts set up in a predetermined contact list. The contact list is then

contacted and the user is contacted with the results. As such, the present invention

permits the user to remain in contact with a significant number of entities while saving

time and effort by ensuring the user is only contacted with certain information. The

system and method also permits the user to remain in contact even when the user is

unavailable. Applicant's arguments have thus been fully analyzed and considered but

they are not persuasive.

After an additional analysis of the applicant's invention, remarks, and a search of

the available prior art, it was determined that the current set of prior art consisting of

Brown (20030112952) and Yoakum (20040059781) discloses the applicant's invention

including disclosures in Remarks dated September 18, 2007.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claim **1 - 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Brown et al. (US PGPUB No. **20030112952**) in view of **Yoakum et al.** (US PGPUB No.

20040059781).

Regarding Claim 1, Brown discloses a method of permitting a user to remain in contact

with at least one other entity comprising:

  a) establishing a contact list comprising the at least one other entity; (see Brown

    paragraph [0026], lines 1-5; paragraph [0064], lines 3-8; paragraph [0077], lines

    1-4: subscriber (user) contact list (entities))

  b) establishing at least one service rule used for contacting the at least one other

    entity, wherein the service rule comprises a user-customizable rule specifying

    information that pertains specifically to the other entity and that is to be elicited

    from the other entity; (see Brown paragraph [0026], lines 8-12; paragraph [0054],

lines 1-5: rule(s) for contacting entities, rules are setup by the user (user

customizable)) and

c) establishing at least one contact rule used for contacting the user after the at

    least one other entity has been contacted. (see Brown paragraph [0079], lines 3-

    6; paragraph [0080], lines 1-6: contact subscriber (user) after entity has been

    contacted)

e) obtaining information from the other entity; (see Brown paragraph [0031], lines 5-

    9; paragraph [0042], lines 1-7; paragraph [0071], lines 3-10: accept or reject call,

    information elicited and obtained from called party) and

f) subsequently conveying the obtained information to the user if the at least one

    contact rule is satisfied. (see Brown paragraph [0057], lines 1-12: information

    about the call (pre-call notification information: could be rejection of call

    information) is convey to user (caller))

Brown discloses wherein when the user is unavailable to initiate contact and eliciting

the specified information according to the at least one service rule;. (see Brown

paragraph [0067], lines 1-8; paragraph [0069], lines 1-5; paragraph [0087], lines 4-8:

schedule, automatic initiation of call (contact); paragraph [0031], lines 5-9;

paragraph [0042], lines 1-7; paragraph [0071], lines 3-10: accept or reject call,

information elicited and obtained)   Brown does not specifically disclose whereby

automatically contacting each entity, on the contact list.

However, Yoakum discloses:

d) <u>automatically contacting each entity, on the contact list</u> (see Yoakum paragraph

[0005], lines 1-6; paragraph [0005], lines 12-14; paragraph [00016], lines 1-9;

paragraph [0018], lines 1-11: contact each entity on contact list to solicit

information concerning entity)

It would have been obvious to one of ordinary skill in the art to modify Brown as

taught by Yoakum to enable the capability to automatically contacting each entity.

One of ordinary skill in the art would have been motivated to employ the teachings of

Yoakum in order to enable the capability for a simple and effective manner to

manage a contact (buddy) list that a subscribing user would like to contact at any

given time. (see Yoakum paragraph [0004], lines 1-7: " ... *Accordingly, there is a*

need for a simple and effective technique to maintain buddy lists, which are highly

reflective of the actual set of individuals that the subscribing user would like to

monitor or contact at any given time. There is a further need to dynamically change

the buddy list as necessary and temporarily select an individual not on the buddy list

to monitor in a dynamic fashion. ... ")

Regarding Claim 2, 8, 14, Brown discloses the method, machine-readable storage,

system of claims 1, 7, 13, wherein the contact list is a database and the contact list

includes information selected from names, phone numbers, email addresses, pager

numbers, and a combination thereof. (see Brown paragraph [0153], lines 5-9: database;

paragraph [0022], lines 1-3; paragraph [0022], lines 10-13; paragraph [0096], lines 11-

14: contact information, e-mail address, name; paragraph [0017], lines 1-4; paragraph

[0018], lines 8-11: software, implementation means)

Regarding Claims 3, 9, 15, Brown discloses the method, machine-readable storage, system of claims 1, 7, 13, wherein the at least one service rule is selected from how to contact the at least one entity, what to ask the at least one entity, a time period to contact the at least one entity, and a combination thereof. (see Brown paragraph [0026], lines 8-12; paragraph [0029], lines 1-6: contact rule(s), how to contact, time period)

Regarding Claims 5, 11, 17, Brown discloses the method, machine-readable storage, system of claims 4, 7, 13, wherein the contact list comprises at least two entities and the user is contacted after each of the at least two entities is contacted if the at least one contact rule has been satisfied. (see Brown paragraph [0020], lines 1-5: subscriber and two entities (two or three parties) involved in contact attempt; paragraph [0079], lines 3-6; paragraph [0080], lines 1-6: subscriber (user) contact when availability exists (rule satisfied))

Regarding Claims 6, 12, 18, Brown discloses the method, machine-readable storage, system of claims 4, 7, 13, wherein the contact list comprises at least two entities and the user is contacted after all of the at least two entities is contacted if the at least one contact rule has been satisfied. (see Brown paragraph [0020], lines 1-5: subscriber and two entities (two or three parties) involved in contact attempt; paragraph [0079], lines 3-6; paragraph [0080], lines 1-6: subscriber (user) contact when availability exists (rule

satisfied))

Regarding Claim 7, Brown discloses a machine-readable storage having stored

thereon, a computer program having a plurality of code sections, the code sections

executable by a machine for causing the machine to perform the steps of:

a) establishing a contact list comprising the at least one other entity; (see Brown

paragraph [0026], lines 1-5; paragraph [0064], lines 3-8; paragraph [0077], lines

1-4: subscriber (user) contact list (entities))

b) establishing at least one service rule used for contacting the at least one other

entity, wherein the service rule comprises a user-customizable rule specifying

information that pertains specifically to the other entity and that is to be elicited

from the other entity; (see Brown paragraph [0026], lines 8-12; paragraph [0054],

lines 1-5: rule(s) for contacting entity, rules are setup by the user)

c) establishing at least one contact rule used for contacting the user after the at

least one other entity has been contacted. (see Brown paragraph [0079], lines 3-

6; paragraph [0080], lines 1-6: contact subscriber (user) after entity has been

contacted)

e) obtaining information from the other entity; paragraph [0031], lines 5-9; (see

Brown paragraph [0042], lines 1-7; paragraph [0071], lines 3-10: accept or reject

call, information obtained) and

f) subsequently conveying the obtained information to the user if the at least one

contact rule is satisfied. (see Brown paragraph [0057], lines 1-12: information

about the call (pre-call notification: could be rejection of call information) is

convey to user (caller))

Brown discloses wherein <u>when the user is unavailable to initiate contact</u> and <u>eliciting</u>

<u>the specified information according to the at least one service rule</u>. (see Brown

paragraph [0067], lines 1-8; paragraph [0069], lines 1-5; paragraph [0087], lines 4-8:

schedule, automatic initiation of call (contact); paragraph [0031], lines 5-9;

paragraph [0042], lines 1-7; paragraph [0071], lines 3-10: accept or reject call,

information elicited and obtained)   Brown does not specifically disclose whereby

automatically contacting each entity, on the contact list.

However, Yoakum discloses:

d) <u>when the user is unavailable to initiate contact, automatically contacting each</u>

   <u>entity, on the contact list</u> (see Yoakum paragraph [0005], lines 1-6; paragraph

   [0005], lines 12-14; paragraph [00016], lines 1-9; paragraph [0018], lines 1-11:

   contact each entity on contact list to solicit information concerning entity)

   It would have been obvious to one of ordinary skill in the art to modify Brown as

taught by Yoakum to enable the capability to automatically contacting each entity.

One of ordinary skill in the art would have been motivated to employ the teachings of

Yoakum in order to enable the capability for a simple and effective manner to

manage a contact (buddy) list that a subscribing user would like to contact at any

given time. (see Yoakum paragraph [0004], lines 1-7)

Regarding Claim 13, Brown discloses a system of permitting a user to remain in contact with at least one other entity comprising:

a) means for establishing a contact list comprising the at least one other entity; (see Brown paragraph [0026], lines 1-5; paragraph [0064], lines 3-8; paragraph [0077], lines 1-4: subscriber (user) contact list (entities))

b) means for establishing at least one service rule used for contacting the at least one other entity; (see Brown paragraph [0026], lines 8-12; paragraph [0054], lines 1-5: rule(s) for contacting entity) and

c) means for establishing at least one contact rule used for contacting the user after the at least one other entity has been contacted. (see Brown paragraph [0079], lines 3-6; paragraph [0080], lines 1-6: contact subscriber (user) after entity has been contacted)

e) <u>obtaining information from the other entity;</u> (see Brown paragraph [0031], lines 5-9; paragraph [0042], lines 1-7; paragraph [0071], lines 3-10: accept or reject call, information obtained) <u>and</u>

f) <u>subsequently conveying the obtained information to the user if the at least one contact rule is satisfied.</u> (see Brown paragraph [0057], lines 1-12: information about the call (pre-call notification: could be rejection of call information) is convey to user (caller))

Brown discloses wherein <u>when the user is unavailable to initiate contact</u> and <u>eliciting the specified information according to the at least one service rule.</u> (see Brown

paragraph [0067], lines 1-8; paragraph [0069], lines 1-5; paragraph [0087], lines 4-8:

schedule, automatic initiation of call (contact); paragraph [0031], lines 5-9;

paragraph [0042], lines 1-7; paragraph [0071], lines 3-10: accept or reject call,

information elicited and obtained) Brown does not specifically disclose whereby

automatically contacting each entity, on the contact list.

However, Yoakum discloses:

d) when the user is unavailable to initiate contact, automatically contacting each

   entity, on the contact list (see Yoakum paragraph [0005], lines 1-6; paragraph

   [0005], lines 12-14; paragraph [00016], lines 1-9; paragraph [0018], lines 1-11:

   contact each entity on contact list to solicit information concerning entity)

   It would have been obvious to one of ordinary skill in the art to modify Brown as

taught by Yoakum to enable the capability to automatically contacting each entity.

One of ordinary skill in the art would have been motivated to employ the teachings of

Yoakum in order to enable the capability for a simple and effective manner to

manage a contact (buddy) list that a subscribing user would like to contact at any

given time. (see Yoakum paragraph [0004], lines 1-7)

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

K H S
Kyung Hye Shin
Patent Examiner
Art Unit 2143

KHS
November 26, 2007